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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,876	08/03/2006	Dietrich H. W. Gronemeyer	GRONEMEYER ET AL-2PCT	7387
25889	7590	05/19/2009	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			MILLER, CHERYL L	
			ART UNIT	PAPER NUMBER
			3738	
			MAIL DATE	DELIVERY MODE
			05/19/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,876

Applicant(s)

GRONEMEYER ET AL.

Examiner

CHERYL MILLER

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

The applicant has argued that Alt (US 6,767,360 B1) does not disclose interruptions that do not lie on top of one another in different layers. The examiner disagrees. Interruptions (where 60, 65 are located in fig.3) do not lie on top of one another, they lie side by side one another. It is noted that the interruptions are not required by the claim to be located in each of the layers. If they were interruptions of the first layer 15 may be considered 12 and interruptions of second layer 50 may be considered 60 and 65, thus if applicant were to claim interruptions located in the struts of each of the two layers, and further the interruptions of the first layer not overlapping the interruptions of the second layer, this would seemingly overcome the Alt rejection.

The applicant has argued that Melzer et al. (US 6,280,358 B1) does not disclose interruptions that do not lie on top of one another in different layers. The examiner disagrees. Interruptions (91) of layers (82 and 82) do not lie *directly* on top of one another, they are separated by layer (81).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5-6, 14, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Alt et al. (US 6,767,360 B1, cited previously). Alt discloses a medical implant (stent 10) having a deformable structural part (10) with an expandable framework structure formed of a plurality of metallic struts (21, 22) connected to one another (see fig.1; col.3, lines 41-53); the structural part (10) composed of multiple layers (15, 51, 50), whereby the layers (15, 50, 51) have different electrical or magnetic properties (each is a different material and thickness, thus inherently different properties). Alt discloses the framework to have interruptions (area at 60, 65), such that closed current paths are avoided in the layers (see fig.3). Alt discloses interruptions in different positions that do not lie on one another (different interruptions 60 and 65 of layer 50 do not on one another, they are spaced longitudinally from one another-it is noted that interruptions are claimed to be in the framework, however not required to be in the struts of each of the two layers-if the interruptions were claimed to be in the metallic struts of each of the two layers, this would overcome the Alt rejection). Alt discloses a continuous current path from one end to another in a helix shape (see fig.3), further that two current path segments that are helices are formed (col.8, lines 45-56). Alt discloses current paths connected at a capacitor (73; fig.4). Alt discloses the frequency to be equal to the frequency of the MR device (col.8, lines 9-12). Alt discloses an insulative intermediate layer (51) between conductive material (15, 50). Alt discloses a method of imaging comprising applying a paramagnetic contrast agent (col.7, lines 25-37) during the imaging process to change the properties of the surrounding tissue (which

includes the blood, inherently it is matching the susceptibility to the implant, this is the purpose of the paramagnetic contrast agent).

Claims 1, 5-11 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Melzer et al. (US 6,280,385 B1, cited in IDS). See figures 3, 4b and respective portions of the specification. Melzer discloses a medical implant (stent 1; fig.1) having a deformable structural part (2) with an expandable framework structure (col.7, lines 22-29) formed of a plurality of metallic struts interconnected (see fig.1) and wherein the structural part is composed of multiple layers (82, 81, 82; fig.4b), whereby the layers (81, 82, 82) have different electrical or magnetic properties (inherent, as they are disclosed to be different materials). Melzer discloses the framework (2) to have interruptions (91; shown in fig.3, 5), such that current paths that are closed are avoided (path shown by arrows in fig.3 extending from one end of the stent to the other, not closed in the layer), the interruptions (91 of both layers 82) situated such that they do not lie directly on top of one another (they are not in direct contact, they are separated by layer 81, thus considered to be not *directly* on top of one another). Melzer discloses a continuous current path from one end to another in a helix shape (fig.3), further that two current path segments (one on each layer 82; col.9 line 65-col.10 line 4) that are helices are formed. Melzer discloses current paths connected at a capacitor (3; fig.2a-2g; col.7, lines 50-58). Melzer discloses the frequency to be equal to the frequency of the MR device (col.8, lines 12-16). Melzer discloses an insulative intermediate layer (81; fig.4b) between conductive material (82's). Applicant may want to consider amendment the claims to require the interruptions to be in the *struts* of each of the two layers, the interruptions of the first layer not overlapping the

interruptions of the second layer, such an amendment would seemingly overcome the Melzer rejection.

Claims 1, 5-7, 12, and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Weber et al. (US 2004/0158310 A1). Weber discloses a medical implant (stent 320; fig.3a-3c) having a deformable structural part with an expandable framework structure (seen in fig.3a) formed of a plurality of metallic struts interconnected (filaments 322) and wherein the structural part is composed of multiple layers (see fig.3b; each filament has 3 layers and filaments also overlap thus 6 layers in some areas of stent), whereby the layers (334, 330, 334) have different electrical or magnetic properties (inherent, as they are disclosed to be different materials). Weber discloses the framework to have interruptions (breaks in insulation along some filaments; shown in fig.3c), such that current paths that are closed are avoided (path follows one filament from one end of the stent to the other in a helical pattern, see fig.3a; no overlap occurs since at the overlap points, at least one layer of insulation is blocking the current path), the interruptions (gaps of insulation, see in fig.3c for example) situated such that they do not lie directly on top of one another (the insulation on two overlapping filaments is not interrupted in the same location, at least one layer of insulation must be present; P0032). Weber discloses a continuous current path from one end to another in a helix shape (fig.3a), further that two current path segments (one on each filament) that are helices are formed. Weber discloses current paths to be in opposite helical directions (P0028; P0039).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alt et al. (US 6,767,360 B1, cited previously) in view of Unger (US 6,884,407 B1, cited previously). Alt discloses a method of MR imaging a medical implant comprising applying a paramagnetic contrast agent near the medical implant in order to regulate the susceptibility of the tissues surrounding the medical implant (col.7, lines 25-37), however is silent to mention any particular contrast agents. Unger teaches in the same field as MR imaging, the use of ferrites as known contrast agents in the field of imaging (evidence of a known particular example) for providing a sufficient image of tissue (metal oxides, iron oxides, col.3, lines 35-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Unger's evidence of known specific contrast agents (ferrites) for MR imaging, with the MR imaging process of Alt in order to provide an image that distinguishes the tissue.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHERYL MILLER whose telephone number is (571)272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cheryl Miller/
Examiner, Art Unit 3738

/Corrine M McDermott/
Supervisory Patent Examiner, Art Unit 3738